

1 UNITED STATES DISTRICT COURT

2 DISTRICT OF NEVADA

3 SMP GmbH & Co KG,

4 Plaintiff,

5 vs.

6 ONU.COM, an Internet domain
name,

7 Defendant.

CASE NO. 2:16-cv-02147-APG-CWH

**EX PARTE TEMPORARY RESTRAINING
ORDER AND ORDER SETTING
HEARING ON PRELIMINARY
INJUNCTION**

(ECF No. 6)

8
9 The plaintiff has filed Emergency Motion for Temporary Restraining Order Without
10 Notice. ECF No. 6. The plaintiff seeks to temporarily disable the domain name <onu.com> (the
11 “Defendant Domain Name”) and place the Defendant Domain Name on “lock” pending the
12 hearing on its motion for preliminary injunction. Good cause exists to enter the requested TRO.

13 THE COURT HEREBY FINDS AS FOLLOWS:

14 On or about October 25, 2013, the plaintiff paid \$30,100.00 to acquire the <onu.com>
15 domain name registration for its new ONU brand from NameJet, a domain name registration
16 reseller located in the United States. The plaintiff immediately moved the registration into its
17 account with eNom, a domain name registrar located in the United States, and placed a “lock and
18 hold” on the registration so as to protect the registration from an inadvertent transfer. Plaintiff
19 also filed for a trademark registration on the ONU mark in Germany.

20 The plaintiff has been working on developing its ONU platform for its new business
21 venture, as well as the brand and how it would be introduced into the market. The plaintiff has
22 spent hundreds of thousands of dollars and countless hours preparing for the launch of ONU,
23 which was anticipated to occur by September 30, 2016.

24 In or around November 2014, the plaintiff’s representatives met with U.S.-based
25 investors in California and New York, among others, to seek capital investment in ONU. During
26 these meetings, the plaintiff presented information about its ONU branded platform through
27 various visual and printed media. All such media conspicuously displayed the plaintiff’s ONU
28

1 trademark. In anticipation of the impending launch, the plaintiff ensured the registration fees on
2 the <onu.com> domain name registration were fully paid and that the registration was locked.

3 On or about May 30, 2016, the plaintiff's CEO received an email from a third party
4 offering to sell the <onu.com> domain name registration to Plaintiff for \$29,000.00. The
5 plaintiff's CEO checked the plaintiff's eNom account and discovered the <onu.com> domain
6 name registration was no longer there. It apparently had been stolen.

7 The plaintiff's account with eNom is maintained on a protected computer system and
8 access to the account is restricted to only a limited number of people with the username and
9 password for the account. The plaintiff conducted an internal investigation and concluded that
10 the transfer had not occurred from within the company. The plaintiff spent several weeks
11 attempting to resolve the issue with eNom and attempting to reclaim the <onu.com> registration,
12 but to no avail.

13 Records indicate that the theft of the Defendant Domain Name occurred on or about
14 March 19, 2016 and was perpetrated by an individual or organization located in China. In the
15 three months following the theft, records show that the Defendant Domain Name was transferred
16 at least five times, including between at least three Chinese registrants, a registrant in the
17 Bahamas who shielded its identity through a privacy service, a registrant in Germany, and then
18 to the current registrant in Austria. During this short time, the Defendant Domain Name was
19 also transferred between two different registrars.

20 The plaintiff will suffer irreparable injury to its valuable trademark and associated
21 goodwill and loss of trade if the Defendant Domain Name is not enjoined and restrained from
22 being transferred to other domain name registrars or registrants and from use of the domain
23 name. "In trademark cases, irreparable harm is typically found [where a plaintiff loses] control
24 over [its] business reputation, loss of trade and loss of goodwill." *Maxim Integrated Prods., Inc.*
25 *v. Quintana*, 654 F. Supp. 2d 1024, 1035-36 (N.D. Cal. 2009). *See also Robinson v. Delicious*
26 *Vinyl Records Inc.*, 2013 WL 3983014, at *7 (C.D. Cal. Aug. 1, 2013) ("Courts have repeatedly
27 found that losing control of one's reputation and good will in the marketplace supports the
28 issuance of an injunction."). The plaintiff has and will continue to suffered irreparable harm

1 through loss of control over its business reputation, loss of trade, and loss of goodwill. The
2 plaintiff has expended time and effort on marketing efforts and promotional activities to build its
3 reputation, goodwill, and business under this domain name. In addition to filing a trademark
4 application for its ONU mark, the plaintiff has invested hundreds of thousands of dollars and
5 man hours developing its ONU platform and on marketing and promotional activities in the
6 United States. The apparent theft of the registration for the Defendant Domain Name has and
7 will continue to deprive Plaintiff of its ability to launch its ONU platform. As a result, the
8 plaintiff has lost control of its business reputation and is suffering significant loss of trade and
9 loss of good will, particularly as to the delay in the launch of the ONU platform.

10 The plaintiff will continue to suffer irreparable injury as long as the registrant of the
11 Defendant Domain Name is permitted to remain unlocked. The registrant of the Defendant
12 Domain Name can capitalize upon and profit from the ONU mark, by linking the Defendant
13 Domain Name to an active website, or by simply selling and/or transferring the domain name to
14 other persons. If the registrant transfers the domain name to another registrant, the plaintiff
15 would be required to file additional lawsuits and keep chasing the Defendant Domain Name as it
16 was passed among subsequent registrants. The issuance of a temporary restraining order will
17 put a stop to the chase and permit the plaintiff the opportunity to enforce its rights without the
18 need for multiple, successive lawsuits.

19 The plaintiff appears likely to succeed on the merits of its cybersquatting claim.

20 The balance of hardships tips in favor of the plaintiff because issuance of the temporary
21 restraining order would merely place the infringing Defendant Domain Name on "lock" pending
22 trial, and failure to issue the restraining order and injunction would cause the plaintiff to suffer
23 additional irreparable injury and incur additional expense by depriving the plaintiff of using its
24 ONU mark as a domain name on the Internet and allowing the registrant of the Defendant
25 Domain Name to capitalize upon the plaintiff's intellectual property and good will without
26 authorization or permission.

1 The issuance of a temporary restraining order is in the public interest because it would
2 protect consumers against deception and confusion in the marketplace arising from registrant's
3 use of the Defendant Domain Name by persons other than the plaintiff.

4 THEREFORE, IT IS HEREBY ORDERED THAT, pending a full trial on the merits:

5 A. World4You Internet Services GmbH (the domain name registrar) and/or Verisign,
6 Inc. (the .com domain registry) shall immediately remove or disable the current domain name
7 server information to the registration for Defendant Domain Name, place the domain name on
8 "lock," and/or provide documents sufficient to establish control and authority regarding the
9 disposition of the registration and use of the Defendant Domain Name with the Court.

10 B. A bond in the amount of \$100.00 shall be required because the evidence indicates
11 that the registrant of the Defendant Domain Name will suffer, minimal damage by the issuance
12 of this temporary restraining order.

13 C. To ensure the registrant of the Defendant Domain Name receives timely notice of
14 the hearing, given that the registrant of the Defendant Domain Name must maintain accurate
15 contact information with the registrar, the plaintiff may, in addition to the requirements of
16 service identified in Fed. R. Civ. P. 4 and 5, serve the Motion, this Order, and all other pleadings
17 filed to date on the registrant of the Defendant Domain Name by e-mail transmission.

18 D. This temporary restraining order shall expire at 11:59 p.m. P.D.T. on September
19 23, 2016 unless otherwise extended or modified by order of this court.

20 E. The hearing on the plaintiff's motion for preliminary injunction will be conducted
21 on **September 23, 2016, at 9:30 a.m.** in courtroom 6C at the Lloyd D. George Federal
22 Courthouse, 333 South Las Vegas Boulevard, Las Vegas, Nevada.

23 ////

24 ////

25 ////

26 ////

27 ////

28 ////

1 F. The Defendant Domain Name, and anyone acting on its behalf or claiming an
2 interest in the Defendant Doman Name, shall file and serve its opposition papers, if any, no later
3 than **September 21, 2016 at noon.** The plaintiff may file and serve its reply brief, if any
4 opposition is filed, no later than **September 22, 2016 at noon.**

5 ENTERED this 13th day of September, 2016 at 1:50 p.m.

6 

7 _____
8 Andrew P. Gordon
9 UNITED STATES DISTRICT JUDGE
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28